UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/721,287	MARSICO ET AL.
	Examiner	Art Unit
	Igor Borissov	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 October 2004</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-7 and 10-46* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-7 and 10-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

Amendment received on 10/29/2004 is acknowledged and entered. Claims 2, 8 and 9 have previously been canceled. Claims 1, 7, 10-15, 17, 19-23, 26-28, 31-32 and 35-42 have been amended. New claims 43-46 have been added. Claims 1, 3-7 and 10-46 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what the claims is directed to: to a server or computer readable medium.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-7, 15-20, 23, 25, 37 and 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement

thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.,* the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman,* 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

The claims of the present application are distinguished from the claims analyzed in the decisions of *State Street, Alappat, Arrhythmia* and *AT&T*, where the claims in these cases clearly involved the use of technology as shown below.

State Street: The claims were in means plus function form and directed to a data processing system for managing a financial services configuration of a portfolio established as a partnership; the claims included limitations of a computer processor means for processing data, a storage means for storing data on a storage medium along with first through fifth means for processing different types of financial data. As such, the claims analyzed in *State Street* clearly involved the technological arts and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

AT&T Corp: The claims were directed to a method for use in a telecommunications system in which interexchange calls initiated by each subscriber are <u>automatically</u> routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber comprising generating a <u>message record</u> for an interexchange call between an originating subscriber and a terminating subscriber, and including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers. In considering these claims, it is clear that technology is being used to "automatically route" calls over the facilities of interexchange carriers and generating a message record for the call. Furthermore, the courts, in analyzing these claims, clearly indicated that they recognized the claims require the use of switches and computers. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1450 (Fed. Cir. 1999). The court further noted that AT&T's claimed process employs subscriber's and call recipients' PICs as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through *switching and recording mechanisms* to create a signal useful for billing purposes. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1453 (Fed. Cir. 1999). As such, the claims analyzed in AT&T clearly involved the technological arts as recognized

by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Alappat: The claims were directed to a rasterizer for converting vector list data representing sample magnitudes of an input waveform into anti-aliased pixel illumination intensity data to be displayed on a display means comprising various means for determining distances and means for outputting illumination intensity data. Alappat's invention related generally to a means for creating a smooth waveform display in a digital oscilloscope and as indicated by the court, Alappat's invention is an improvement in an oscilloscope comparable to a TV having a clearer picture. The court reasoned that invention was statutory because the claimed invention was directed to a "machine". See *In re Alappat*, 31 USPQ2d at 1552-54 (Fed. Cir. 1994). Furthermore, in the decision of *AT&T Corp.*, the courts recognized that the claims in Alappat were for a machine that achieved certain results. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 50 USPQ2d at 1452 (CAFC 1999). Once again, these claims clearly involve the technological arts as recognized by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Arrhythmia: The claims were directed to a method for analyzing electrocardiograph signals to determine the presence or absence of a predetermined level of high frequency energy in the late QRS signal including the step of converting a series of QRS signals to time segments, each segment having a digital value equivalent to the analog value of said signals at said time. In considering these claims, it is clear that technology is being used to convert a series of QRS signals to time segments having a digital value. Once again, these claims clearly involve the technological arts since one could not convert a signal to a time segment having a digital value without the aid of a computer or some processing device and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Contrary to the claims in the above-cited cases, in the present application,
claims 1, 3-7, 15-20, 23, 25, 37 and 39 are completely silent with regard to technology
and is purely an abstract idea or process steps that are employed completely without
the use of any technology whatsoever. The claims are no more than a suggested idea
of complaining to law enforcing authority about unwanted calls.

The method step: "*generating, from a user communications terminal, ... a
complaint registration message*" may be understood as merely using a telephone for
complaining to law enforcing authority about unwanted calls. However, the claimed
invention must utilize technology in a non-trivial manner (*Ex parte Bowman, 61 USPQ2d
1665, 1671 (Bd. Pat. App. & Inter. 2001)*). Although Bowman is not precedential, it has
been cited for its analysis.

Furthermore, in accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process
Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296,
30 USPQ2d at 1460. To be statutory, a claimed computer related process must either:
(A) result in a physical transformation outside the computer for which a practical
application in the technological arts is either disclosed in the specification or would have
been known to a skilled artisan, or (B) be limited to a practical application within the
technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6
(quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The claims in the present
application do not appear to satisfy either of the two conditions listed above. First, the
claims do not include limitations that would suggest a computer is being used to
transform the data from one form to another that would place the invention in the
technological arts. Second, disregarding the fact that there is no computer claimed that
would physically transform the data, there does not appear to be any physical
transformation of data. The claims merely *recite receiving a signaling message,
extracting a parameter from the message and determining whether the communication
is from a communication initiator with whom communication is not desired;* wherein said
parameter appears to be an arbitrary abstract thing and not a discrete value resulting
from a calculation of this parameter by a computer or processor. Thus, there neither
appears to be any physical transformation of data from one form to another which is

based upon an algorithm or a calculation by a computer or processor, nor is there any
technology claimed that would be used to transform the data.

Because the independently claimed invention is directed to an abstract idea
which does not recite a limitation in the technological arts, those claims and claims
depending from them, are not permitted under 35 USC 101 as being related to non-
statutory subject matter. However, in order to consider those claims in light of the prior
art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

**Claims 1, 4, 6, 7, 26, 29, 31-33, 37, 38, 41, 44 and 46 are rejected under 35
U.S.C. 102(e) as being anticipated by Mukherjee et al. (US 6,449,474) (Mukherjee).**

Mukherjee teaches a computer implemented method and system for providing
call interception, comprising:

Independent Claims.

Claims 1, 26 and 46. Receiving an incoming call signaling message from a
communication initiator (C. 6, L. 6-10); identifying (extracting a parameter) from the call
signaling message and determining whether the communication is from a
communication initiator with whom communication is not desired (C. 6, L. 10-22); in
response to determining that the communication is from a communication initiator with
whom communication is not desired, generating a complaint registration message
identifying said initiator using said identifying information and transmitting said message

to law enforcing agency computer over a network using TCP/IP protocol (C. 6, L. 23-26).

Claim 4. See reasoning applied to claim 1.

Claim 6. Said method wherein said parameter is telephone number of the initiator (C. 5, L. 55).

Claim 7. Said method wherein said parameter is mobile telephone number of the initiator (C. 5, L. 55).

Claim 29. See reasoning applied to claim 26.

Claim 31. See reasoning applied to claim 1.

Claim 32. Said server is adapted to send the violation notification to a law enforcing agency (third party) (C. 6, L. 23-26).

Claim 33. Said server is adapted to send the violation notification to a law enforcing (government) agency (C. 6, L. 23-26).

Claim 37 and 41. Providing communication in TCP/IP protocol (C. 6, L. 23-26).

Claim 38. See reasoning applied to claim 1.

Claim 44. See reasoning applied to claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view of Pinder et al. (US 6,701,160) (Pinder).

Dependent Claim.

Claim 3. Mukherjee teaches all the limitations of claim 3, except specifically teaching that said communication is a short message service message.

Pinder teaches a method and system for locally blocking incoming selected calls, wherein said incoming calls are short message service messages (C. 1, L. 65 – C. 2, L.1).

It would have been obvious to one having ordinary skill in the art to modify Mukherjee to include that said communication is a short message service message, as disclosed in Pinder, because it would advantageously increase the application field of the system, thereby increase revenue.

Claims 5, 28, 34-36, 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view of Correia, II (US 5,926,534) (Correia).

Independent Claim.
Claim 45. Mukheree teaches said system including a computer-readable medium including instruction to execute a method, comprising: receiving an incoming call signaling message from a communication initiator (C. 6, L. 6-10); identifying (extracting a parameter) from the call signaling message and determining whether the communication is from a communication initiator with whom communication is not desired by performing a lookup in a table (C. 6, L. 1-5, 10-22); in response to determining that the communication is from a communication initiator with whom communication is not desired, generating a complaint registration message identifying said initiator using said identifying information and transmitting said message to law enforcing agency computer over a network using TCP/IP protocol (C. 6, L. 23-26).

Mukherjee does not specifically teach that said compliant registration message is generated *upon detecting that a manual trigger has been generated by the user* communication terminal during said communication.

Correia teaches a method for blocking unwanted calls for a computer system, including comparing an incoming call phone number with a list of authorized phone numbers, and blocking said call if said incoming call phone number does not match with said list, wherein said call is a facsimile message (C. 2, L. 25-28), wherein said system

is incorporated into a personal computer (C. 4, L. 50-51), thereby indicating user interaction with said personal computer.

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include generating said compliant registration message upon detecting user interaction with said personal computer during said communication, as disclosed in Correia, because it would advantageously allow user to adjust the system to any unexpected calls.

Dependent Claims.

Claim 5. Mukheree teaches all the limitations of claim 5, except specifically teaching that said communication is a facsimile message.

Correia teaches a method for blocking unwanted calls for a computer system, including comparing an incoming call phone number with a list of authorized phone numbers, and blocking said call if said incoming call phone number does not match with said list, wherein said call is a facsimile message (C. 2, L. 25-28).

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include that said communication is a facsimile message, as disclosed in Correia, because it would advantageously increase the application field for the system, thereby increase revenue.

Claim 28. Correia teaches that the communication terminal is a personal computer (C. 4, L. 50-51). The motivation to combine Mukherjee with Correia would be to advantageously increase the application field for the system, thereby increase revenue.

Claim 34. Correia teaches that the communication terminal is a personal computer (C. 4, L. 50-51), thereby indicating a user interaction. The motivation to combine Mukherjee with Correia would be to advantageously increase the application field for the system, thereby increase revenue.

Claim 35. Correia teaches said personal computer (terminal) includes a call blocking database (C. 3, L. 38-40).

Claim 36. See reasoning applied to claim 20.

Claim 43. Correia teaches that said *blocking* functionality is incorporated into a modem (C. 4, L. 49-67). Official Notice is taken that it is well known to incorporate a modem into a computer. Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee and Correia to include that said *blocking* functionality is incorporated into a computer (communications terminal), because it would advantageously simplify the use of the system and decrease operation cost by scaling it down to be used by a single person.

Claims 10-14, 17-18, 21-24, 27, 30, 39, 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee.

Mukherjee teaches a method and system for providing call interception, comprising:

Independent Claim.

Claim 20. Receiving an incoming call signaling message from a communication initiator (C. 6, L. 6-10); identifying (extracting a parameter) from the call signaling message and determining whether the communication is from a communication initiator with whom communication is not desired (C. 6, L. 10-22); in response to determining that the communication is from a communication initiator with whom communication is not desired, generating a complaint registration message identifying said initiator using said identifying information and transmitting said message to law enforcing agency computer over a network using TCP/IP protocol (C. 6, L. 23-26).

Mukherjee does not specifically teach that said determining step includes determining whether said communication initiator has previously been notified not to initiate communication.

However, Mukherjee teaches that it is difficult to track or intercept unwanted call initiators, which allows a malicious call initiators to allude monitoring agencies (C. 1, L. 64-67), which, in turn, indicates a repetitive character of said unwanted calls, including making repetitive calls using the same number, and been asked by disturbed subscribers of said numbers not to call again.

Thereby, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include that said determining step includes determining whether said communication initiator has previously been notified not to initiate communication, because it would advantageously allow to prevent unwanted calls from all type of unwanted callers, including those who was previously notified, and who was not.

Dependent Claims.

Claims 10-11. Same reasoning as applied to claim 20.

Claim 12. Transmitting a violation notification to law enforcing (C. 6, L. 23-26).

Claim 13. Transmitting a violation notification to one of designated law enforcing agency (C. 6, L. 23-26; C. 7, L. 44-45). Information as to "*local* law enforcing agency" is non-functional language and given no patentable weight. Non-functional descriptive material <u>cannot</u> render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter <u>how</u> the process steps are to be performed.

Claim 14. Transmitting a violation notification to law enforcing (government) agency (C. 6, L. 23-26).

Claims 17-18, 23-24, 27 and 30. Providing communication in TCP/IP protocol environment obviously indicates use of SIP protocol.

Claims 21, 22, 40 and 42. See reasoning applied to claim 20.

Claim 39. Providing communication in TCP/IP protocol (C. 6, L. 23-26).

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view Ardon (US 5,751,800).

Dependent Claims.

Claim 15. Murkherjee teaches all limitations of claim 15, except specifically teaching *in response to receiving the call signaling message from the communication initiator, notifying the communication initiator that these calls are not accepted.*

Ardon teaches a method and system for screening of incoming calls prior to call completion, wherein, upon receiving unwanted call, a message that this call are not accepted is send to the call initiator (C. 3, L. 15-19).

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Murkherjee to include notifying the communication initiator that these calls are not accepted in response to receiving the call signaling message from the communication initiator, as disclosed in Ardon, because by warning the call initiators of undesirability of his action, it would advantageously allow said caller to avoid possible future interaction with a law enforcing agency.

In response to receiving the call signaling message from the communication initiator, notifying the communication initiator that these calls are not accepted (column 3, lines 15-19).

Claim 16. Murkherjee and Ardon teach all the limitations of claim 16, including in response to receiving the call-signaling message from the communication initiator, notifying the communication initiator that these calls are not accepted (Ardon; C. 3, L. 15-19).

However, Murkherjee and Ardon do not specifically teach that notifying the communication initiator includes notifying that the complaint registration message is being sent to a complaint registration database.

Official notice is taken that it is well known to warn unwanted telemarketers (communication initiators) that further calls would result in a complaint to an appropriate authority. It is also well known that to pursue the legal action against unwanted contacts, one has to prove that the unwanted entity has been warned that said contacts are unwanted.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Murkherjee and Ardon to include notifying

the communication initiator that the complaint registration message is being sent to a complaint registration database, because it would prevent the communication initiator from calling to the recipient again.

Claims 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view of Almgren et al. (US 6,668,175) (Almgren).

Dependent Claims.

Claims 19 and 25. Mukherjee teaches all the limitations of claims 19 and 25, except specifically teaching that extracting parameter from the signaling message includes extracting a parameter *form the From field of the invite message.*

Almgren teaches a method and system for providing rules-defined communication services, including blocking calls, using session initiation protocol, wherein the session is identified and characterized by means of the packet headers (encapsulating the message), from which various parameters, including identification data, can be extracted (C. 8, L. 12-25).

It would have been obvious to one having ordinary skill in the art to modify Mukherjee to include extracting identifying data from the invite message, as disclosed in Almgren, because it would advantageously allow to keep track of sources of incoming messages, thereby helping law enforcement agencies to identify most active suspects.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-7 and 10-46 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649 before April 13, 2005, and (571) 272-6801 after that date.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist before April 13, 2005, whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702 before April 13, 2005, and (571) 272-6812 after that date.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306   [Official communications; including After Final

communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Igor Borissov
Patent Examiner
Art Unit 3629

IB
02/16/2005